REMARKS

Applicants respond to the final Office Action ("Office Action") mailed on August 12, 2005 as follows. Claims 1-18 are currently pending. Claims 1, 2, 6-10, 12, 13, 16, and 18 stand rejected as allegedly being anticipated by U.S. Patent No. 6,912,503 to Buddle *et al.* ("Buddle"). Claims 3-9, 11, 14, 15, and 17 stand rejected as allegedly being obvious over Buddle. Applicants respectfully request reconsideration of all rejections in view of the present Request for Continued Examination and the following remarks.

I. Buddle Fails To Disclose Retrieving A Predetermined Control Procedure

Claim 1 recites "the computer retrieving one or more predetermined control procedures ... for complying with business policies associated with said selected business risk element." Claim 10 recites "for at least one subrisk element, the computer retrieving one or more predetermined control procedures ... for complying with business policies associated with said identified subrisk element." Claim 14 recites "for at least one of said business risk elements, the computer retrieving one or more predetermined control procedures ... for complying with business policies associated with said business risk element." Claim 16 recites "receiving a second signal identifying a user selection of one or more control procedures associated with each said business risk element ... for complying with business policies associated with said risk elements." Buddle fails to disclose these limitations.

Buddle fails to disclose retrieving a predetermined control procedure. In fact, Buddle fails to disclose any predetermined means for complying with business policies associated with risk elements. As best understood by Applicants, the Examiner alleges that Buddle's "action plans" meet the limitations under discussion. However, assuming, without conceding, that Buddle's "action plans" correspond with the present "control procedures," Buddle still fails to disclose retrieving predetermined control procedures. Rather than being retrieved, Buddle is perfectly clear that its "action plans" are created by compliance officers:

- "[A]n action plan for one or more compliance issues may be created at step 18." Col. 2, ll. 66-67 (emphasis added).
- "At step 18, an action plan for one or more compliance issues may be created. An action plan may be developed in a form that most effectively addresses the type of

compliance issue identified. For example, an action plan may be created for a single issue." Col. 5, ll. 17-22 (emphasis added).

- "At step 380, an action plan may be created or developed for issue resolution." Col. 7, ll. 60-61 (emphasis added).
- "The compliance officer may develop an action plan for resolving the issue ..." Col. 9, ll. 31-32 (emphasis added).

Thus, Buddle fails to disclose any form of retrieving predetermined control procedures.

That Buddle fails to meet this limitation is unsurprising. Buddle is generally directed to passively handling newly-created action plans, rather than actively presenting predetermined control procedures. Buddle's disclosure that the action plans are created, rather than retrieved, is entirely consistent with this theme.

Under 35 U.S.C. § 102, anticipation requires that a prior art reference disclose each and every element of the claimed invention. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). MPEP § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), reinforces this principle: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Because Buddle fails to disclose retrieving a predetermined control procedure, Applicants respectfully request that the rejections of claims 1, 10, 14 and 16, and all claims dependent thereon be withdrawn.

II. Buddle Fails To Disclose Selecting A Business Risk Element From A List Displayed To A User

Claim 1 recites "a computer receiving a user selection of a business risk element from a business risk element list which is displayed to the user, said business risk element list being retrieved from a database coupled to said computer." Claim 10 recites "a computer receiving a user selection of a business risk element from a business risk element list which is displayed to a user on a display terminal of the computer, said business risk element list being retrieved from a database coupled to said computer." Claim 16 recites "the computer receiving a first signal identifying a user selection of a set of business risk elements from a business risk element list

which is displayed to a user, said business risk elements being stored in said database." Buddle fails to disclose these limitations.

Buddle never suggests, considers, discusses, or refers in any way to displaying a business risk element list to a user. As best understood by Applicant, the Examiner asserts that Buddle's "compliance issues" or "risks" meets this limitation. However, there is absolutely no disclosure of a list of anything corresponding to business risk elements, let alone displaying such a list to a user. Buddle completely fails to disclose a displaying a list of compliance issues to a user.

Buddle also fails to disclose a user selecting a business risk element from a list. Even assuming, without conceding, that Buddle's "risk" or "compliance issue" corresponds to the present "business risk element," Buddle yet fails to disclose that a user selects such an element. At most, Buddle discloses that a user develops a compliance issue him or herself. There is absolutely no disclosure of a user being able to select a business risk element from a list that is displayed.

Anticipation under 35 U.S.C. § 102 requires that a prior art reference disclose each and every element of the claimed invention. *In re Sun* (Fed. Cir. 1993); *Verdegaal Bros. v. Union Oil Co. of California* (Fed. Cir. 1987); MPEP § 2131 (quoting *Verdagaal Bros.*, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.") Because Buddle fails to disclose a business risk element list displayed to a user, Applicants respectfully request that the rejections of claims 1, 10 and 16 and all claims dependent thereon be withdrawn.

III. Buddle Fails To Disclose A Weight Assigned To Each Control Procedure

Claim 1 recites "in response to the retrieving of the control procedures, the computer retrieving a weight assigned to each of said predetermined control procedures." Claim 10 recites "the computer retrieving a weight assigned to each one of said predetermined control procedures." Claim 14 recites "the computer retrieving a weight assigned to each one of said predetermined control procedures." Claim 16 recites "the computer receiving a third signal assigning a weight to each said control procedure." Buddle fails to disclose these limitations.

Buddle fails to disclose a weight assigned to a predetermined control procedure. In fact, as discussed above in Section I, Buddle fails to disclose a predetermined control procedure at all,

let alone a weight assigned to the same. As best understood by Applicants, the Examiner asserts that one of Buddle's "severity score," "occurrence score" or "detection score" correspond to the claimed "weight." However, none of these parameters are assigned to anything that corresponds to a "predetermined control procedure." Instead, these parameters are applied to other parameters that relate to risk. The present claim limitations, by contrast, are directed to compliance. With respect, risk is not compliance. In short, Buddle does not assign anything resembling a weight to anything resembling a control procedure.

Buddle also fails to disclose a computer retrieving a weight assigned to a predetermined control procedure. Assuming, without conceding, that one of Buddle's "severity score," "occurrence score" or "detection score" correspond to the claimed "weight," Buddle still fails to disclose that any of these parameters are "retrieved." Buddle at most discloses passively receiving questionnaire information, rather than a computer actively retrieving a weight.

Buddle also fails to disclose retrieving a weight in response to retrieving control procedures. Buddle lists several instances where a self-assessment tool may be used. Even assuming, without conceding, that Buddle's self-assessment tool somehow relates to the claimed "weight," Buddle fails to disclose that it is used in response to retrieving a control procedure. Buddle itself enumerates several instances where a self-assessment tool may be used:

> The self-assessment tool may be conducted at a predetermined interval, such as monthly, quarterly, semi-annually, annually, or other interval of time. The self-assessment tool may be available to the compliance officer as a means to assess business risk at any time, on an ongoing basis. This tool may be administered whenever a business undergoes significant change (e.g., the implementation of new type of product, utilization of different methods of distribution, or exposure to new regulatory risks).

Col. 8, ll. 19-27. Strikingly absent from this list is any reference to using a self-assessment tool in response to retrieving a control procedure.

As the Examiner is well aware, anticipation under 35 U.S.C. § 102 requires that a prior art reference disclose each and every element of the claimed invention. *In re Sun* (Fed. Cir. 1993); *Verdegaal Bros. v. Union Oil Co. of California* (Fed. Cir. 1987); MPEP § 2131 (quoting *Verdagaal Bros.*, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.") Because

Buddle fails to disclose a weight assigned to each control procedure, Applicants respectfully request that the rejections of claims 1, 10, 14 and 16 and all claims dependent thereon be withdrawn.

VII. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below-listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

No fee is believed to be required for entry and consideration of this timely Reply. Nevertheless, in the event that the U.S. Patent and Trademark Office requires a fee to enter this Reply or to maintain the present application pending, please charge such fee to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,
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